

PATENT
Attorney Docket No. 06530.0008-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Charles R. SLATER) Group Art Unit: 3739
Application No.: 09/177,502) Examiner: Michael F. Peffley
Filed: October 23, 1998)
For: BIPOLAR ENDOSCOPIC SURGICAL) Confirmation No.: 3247
SCISSORS BLADES AND)
INSTRUMENT INCORPORATING)
THE SAME)

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION FOR PATENT TERM ADJUSTMENT
DUE TO EXAMINATION DELAY UNDER 37 C.F.R. § 1.181

Applicant hereby petitions the Commissioner for Patents, under the provisions of 37 C.F.R. § 1.181 and M.P.E.P. § 2720, to adjust the extension of patent term recited on the Determination of Patent Term Extension under 35 U.S.C. § 154(b) to 1575 days.

This petition is being filed before or with the issue fee payment.

Applicant received the Determination of Patent Term Adjustment with the Notice of Allowance and Fee(s) Due mailed from the Patent and Trademark Office (PTO) on July 11, 2011, advising that this application is entitled to 1516 days of patent term adjustment.

Applicant has calculated a patent term adjustment of 1575 days based on the following facts:

This application was filed on October 23, 1998, so that the provisions for extension of patent term due to 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701 apply.

On October 23, 2000, a Notice of Appeal to the Board of Appeals and Interferences was filed.

On September 29, 2004, a favorable decision from the Board was mailed, which reversed the examiner's rejections and returned the application to the examiner for further *ex parte* prosecution.

On December 7, 2010, an interference involving this application (Interference No. 105,782) was declared by the Board.

On February 22, 2011, the Board mailed a favorable interference decision (attached as Exhibit A).

On April 22, 2011, the time period to appeal the interference decision to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. § 141, or for commencing a civil action in a federal district court under 35 U.S.C. § 146, expired pursuant to 37 C.F.R. § 1.304(a).

For this application filed in 1998, the patent term adjustment includes extensions for delay due to: (1) appellate review by the Board according to the provisions of 37 C.F.R. §§ 1.701(a)(3) and 1.701(c)(3), and (2) an interference proceeding according to the provisions of 37 C.F.R. §§ 1.701(1)(1) and 1.701(c)(1)(i).

Delay Due to Appellate Review

Applicant does not dispute the PTO's calculation of 1438 days of examination delay due to appellate review. Pursuant to 37 C.F.R. § 1.701(c)(3), the period of examination delay for an application involved in an *ex parte* appeal to the Board of Patent Appeals and Interferences is the number of days beginning on the date on which an appeal to the Board was filed, here October 23, 2000, and ending on the date of a favorable final decision by the Board, here September 29, 2004. This results in a adjustment of 1438 days of examination delay due to appellate review.

Delay Due to Interference Proceeding

Applicant disputes the PTO's calculation of 78 days of examination delay due to the interference proceeding. Delay due to interference proceedings is calculated under 37 C.F.R. § 1.701(c)(1)(i), which specifies that the period of examination delay for an application involved in an interference is the number of days beginning on the date the interference was declared, here December 7, 2010, and ending on the date the interference was terminated. The termination date of the interference is defined in 37 C.F.R. § 41.205 as follows:

After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had. If . . . a civil action (under 35 U.S.C. 146) has been filed the interference is considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires.

The time for appealing a final interference decision under either 35 U.S.C. § 141 or § 146 is defined in 37 C.F.R. § 1.304 as two months from the date of the final decision of the Board. Thus, the termination date for the interference is two months beyond the

decision date of February 22, 2011, which is April 22, 2011. Applicant notes that the PTO used the interference decision date of February 22, 2011, as the end date for calculating the interference delay - not the termination date of April 22, 2011 - to arrive at an adjustment of 78 days. Instead, the adjustment due to interference delay is 137 days, *i.e.*, the number of days between December 7, 2010, the date the interference was declared, and April 22, 2011, the date when the interference was terminated.

Applicant submits that it is entitled to a patent term adjustment of 137 days due to the interference proceeding plus 1438 days for the previous appellate review, resulting in a total of 1575 days of adjustment. Applicant respectfully requests that the current patent term adjustment be reconsidered.

Applicant does not believe that any fee is due with this petition. However, if a fee is due, please charge Deposit Account 06-0916. If there are any other fees due in connection with the filing of this request, please charge them to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 26, 2011

By:

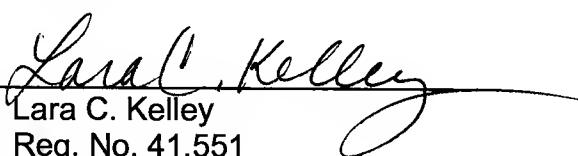

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EXHIBIT A

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Paper 22
Filed: February 22, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MARK A. RYDELL
Junior Party
(Reissue Patent 36,795)¹

v.

CHARLES R. SLATER
Senior Party
(Application 09/177,502)²

Patent Interference No. 105,782
(Technology Center 3700)

Before: JAMESON LEE, SALLY C. MEDLEY, and MICHAEL P. TIERNEY,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

Judgment – Request for Adverse – Bd. R. 127(b)

¹ Based on Application 08/724,997, filed October 3, 1996, to reissue Patent 5,352,222, based on Application 08/213,671, filed March 15, 1994. The real party in interest is Gyrus Medical, Inc.

² Filed October 23, 1998. Accorded the benefit of Application 08/354,992, filed December 13, 1994. The real party in interest is Boston Scientific Miami Corporation.

Interference No. 105,782

Rydell v. Slater

1 On February 11, 2011, junior party Rydell filed a paper titled “RYDELL
2 REQUEST FOR ADVERSE JUDGMENT” in which it is stated that Rydell
3 disclaims its claims 15-17 and that because Rydell has disclaimed its claims 15-17
4 it no longer has a claim involved in this interference. On that basis Rydell further
5 states that the Board should enter judgment against Rydell.

6 Claims 15-17 are all of Rydell’s claims corresponding to the count. Per
7 37 C.F.R. § 127(b)(2), such a disclaimer of all of a party’s claims corresponding to
8 the count constitutes a request for entry of adverse judgment.

9 The request is herein *granted*.

10 It is

11 **ORDERED** that judgment on priority as to Count 1 is entered against junior
12 party MARK A. RYDELL;

13 **FURTHER ORDERED** that involved claims 15-17 of junior party’s
14 Reissue Patent 36,795 are herein cancelled;

15 **FURTHER ORDERED** that the parties shall note the requirements of
16 35 U.S.C. §135(c) and Bd.R. 205; and

17 **FURTHER ORDERED** that a copy of this judgment shall be entered into
18 the file of Reissue Patent 36,795, and Application 09/177,502.

Interference No. 105,782

Rydell v. Slater

1 By Electronic Transmission:

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